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| 09/682,853 | 10/24/2001 | Scott C. Harris | DIY-Internet/SCH | 9828 |

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| EXAMINER |
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BARQADLE, YASIN M

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| ART UNIT | PAPER NUMBER |
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2153

DATE MAILED: 06/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/682,853

Applicant(s)

HARRIS, SCOTT C.

Examiner

Yasin M Barqadle

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-10, 17-21 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Art Unit: 2153

Response to Amendment

1. The amendment filed on March 31, 2004 has been fully considered but they are not persuasive.

- Claims 4, 11-16 and 22 have been canceled.
- Claims 1-3, 5-10, 17-21 and 23 are pending.

Response to Arguments

In response to applicant's argument in page 7, last paragraph, ``that the combination could not be operatively made by one of ordinary skill in the art, since making the combination would require contradicting the teaching of the Chen reference'', the test for obviousness is not whether the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Furthermore, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21

Art Unit: 2153

USPQ2d 1941 (Fed. Cir. 1992). In this case, examiner has shown a suggestion and motivation that is found in Steele et al.

In response to applicant's argument in page 10, last paragraph that ``Steele does not suggest requesting more information about a query sent from an interactive device with the purpose of querying a publicly available source of information.'' This argument is not persuasive because Steele discloses a user of an interactive device sending a request message to a system (§ 0111-0112, page 7) and requesting more information from the user of the interactive device, if the information was not was not supplied in the original update message (§ 0129-0132, page 9).

In response to applicant's argument in page 12, first paragraph that `` Steele teaches nothing about any messages confirming any action''. Applicant's attention is directed to (paragraph 0117, page 7) where Steele discloses messages requiring user interaction and ensuring that a required confirmation is received if it is determined that confirmation is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 2153

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 recites the limitation "said publicly accessible source" in line 5. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

3. Claim 1 recites the limitation "said request" in line 6. It is not clear which request is being referring to, the request in line 1 or 2. Appropriate correction is required.

4. Claim 17 recites the limitation "the first form" in line 7. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2153

5. Claims 1-3, 5-7, 16-21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al US. PUB. (20020177453) in view of Steele et al US PUB (20020046084).

As per claim 1, Chen et al teach a method, comprising:

 sending a request for information from an interactive device (Fig. 1, 214) to a first recipient (Fig. 1, 100) [Page 1, paragraphs 0009-0013];

 at said first recipient, using information from said request to query a publicly accessible source of information (Fig. 5, 352) [Page 1, paragraphs 0011-0014];

 receiving results from querying said source of information, reformatting said results into a new form [page 1, paragraphs 0010-0014 and page 4, paragraphs 0047-0058]; and

 sending said results in said new form to said interactive device [Page 1, paragraphs 0011-0014].

Although Chen et al shows substantial features of the claimed invention, he does not explicitly show requesting an interactive device to identify more information about a specific query to be made to a publicly accessible source of information.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Chen et al, as evidenced by Steele et al USPN. (20020046084). In analogous art, Steele et al whose invention is about a configurable multimedia information system that supports

Art Unit: 2153

electronic commerce, disclose sending a request from a first recipient (system 10) to an interactive device (user with interactive device fig. 1 and 10), requesting said interactive device to identify more information about a specific query to be made to set publicly accessible source of information (Vendor) [page 9, paragraphs 0129-0134]. Giving the teaching of Steele et al, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Chen et al by employing the system of Steele et al in order to provide users beneficial up-to-date information that is consistent with their preference of services and products.

As per claim 2, Chen et al teach a method as in claim 1, wherein said reformatting said information comprises assembling a message which includes some, but not all, of the information received from said publicly accessible source of information [page 1, paragraphs 0010-0014 and page 4, paragraphs 0047-0058].

As per claim 3, Chen et al teach a method as in claim 1, wherein said reformatting comprises reformatting said information into a text message [Page 1, paragraphs 0014].

As per claim 5, Chen et al teach a method as in claim 2, wherein said interactive device also stores personal information associated with a user of the interactive device, and wherein said sending comprises sending a request for

Art Unit: 2153

information which includes some of said personal information [page1, paragraphs 0010-0014 and page 4, paragraphs 0047-0058].

As per claim 6, Chen et al teach a method as in claim 5, wherein said personal information which is sent, includes logon information and a password [Page 1, paragraphs 0011 and Page 6, paragraphs 0075-0085].

As per claim 7, Steele et al teach a method as in claim 6, further comprising signifying to said source of information an indication to purchase a product [paragraph 0063 and paragraphs 0131-0134].

As per claim 17, is a method with similar limitations as claim 1 above. Therefore, it is rejected with the same rationale.

As per claim 19, Chen et al teach the invention, wherein said reformatting comprises reformatting the information into an XML format [Page 4, paragraphs 0054].

As per claim 20, Chen et al teach the invention, wherein said reformatting the information comprises reformatting the information into a text format [Page 4, paragraphs 0055-0058].

As per claim 21, Chen et al teach a method, comprising:

Sending a text message for an e-mail pager (Fig. 1, 214 and 216), to a specified address (fig. 1, 100), said text message including text content indicating an action that the user wants

Art Unit: 2153

to carry out on the internet [page1, paragraphs 0010-0011 Page 3, paragraphs 0039 and page 4, paragraphs 0053-61];
Second sending back a text message back to said email pager [page1, paragraph 0014 and page 4, paragraphs 0055-0059]; and after said second sending, at associated with said specified address, translating said text message into an actual operation to be carried out on the internet, and carrying out said operation on the terminal, and returning a result from said operation on the Internet to said e-mail pager [page1, paragraphs 0010-0014 and page 4, paragraphs 0047-00589. See also paragraphs 0071-0074].

As per claim 23, Steele et al teach the invention as modified, wherein said second sending is a request for information of contents of said action [page 7, paragraph 0117].

6. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al US. PUB. (20020177453) in view of Rajan et al USPN (6633910).

As per claim 9, Chen et al teach a method comprising:
sending a request for information from an interactive device (Fig. 1, 214) to a first recipient (Fig. 1, 100) and Page 1, paragraphs 0009-0014];

at said first recipient, using information from said request to query publicly accessible source information sending

Art Unit: 2153

a request for information from an interactive device [Page 1, paragraphs 0009-0014];

receiving results from querying said source of information [Page 1, paragraphs 0011-0014];

Reformatting said result into a new form to said interactive device [page1, paragraphs 0010-0014 and page 4, paragraphs 0047-0058];

wherein said reformatting said information comprises assembling a message which includes some, but not all, of the information received from said publicly accessible source of information [page1, paragraphs 0010-0014 and page 4, paragraphs 0047-0059. see also paragraphs 0071-0076].

Although Chen et al shows substantial features of the claimed invention, he does not explicitly show reformatting information according to a prestored template.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Chen et al, as evidenced by Rajan et al (6633910).

In analogous art, Rajan et al whose invention is about a system that allows virtually any Internet-based data to be accessed, restructured and then transmitted to wide variety of network-capable appliances, discloses a unique capability of restructuring data and converting it from one format to a format specific to applications executable on a receiving device where an algorithm is employed that can take information from provided

Art Unit: 2153

input data-templates and restructure the information to fit pre-designed and associated output data-templates that is stored in a storage facility for requesting user[col. 7, lines 56-64 and col. 8, lines 55-65].

Giving the teaching of Rajan et al, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Chen et al by employing the system of Rajan et al in order to facilitate the format in which requested data is expected to be found and to enhance the support of different formats and applications.

As per claim 10, Chen et al teach a method as in claim 2, wherein said reformatting comprises reformatting said information into an XML form [Page 4, paragraphs 0054].

As per claim 8, Rajan et al teach the invention, wherein said source information indicates a user's bank balance [Col. 13, lines 44-63 and col. 15, lines 50 and 62].

Conclusion

7. The prior made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin

Art Unit: 2153

Barqadle whose telephone number is 703-305-5971. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 703-305-9717. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Yasin Barqadle

Art Unit 2153

A handwritten signature in black ink, appearing to read 'Dung C. Dinh', with a long horizontal flourish extending to the right.

Dung C. Dinh
Primary Examiner